

Remarks/Arguments:

Applicants thank the Examiner for the courtesy of the May 7, 2009 telephone interview. A summary of the interview is set forth in the remarks below.

Claim Rejections Under 35 U.S.C. §§102 and 103

Claims 1, 4-5 and 20-21 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Published Application No. 2008/0027552 (Zucherman et al.). Claim 3 stands rejected under 35 U.S.C. §103(a) as unpatentable over Zucherman et al. Applicant respectfully traverses these rejections.

Independent claim 1 recites “[a]n implant insertion device comprising: an insertion rod having a longitudinal axis; and an implant gripper attached to said insertion rod, said implant gripper including: a v-shaped gripping surface intersecting the longitudinal axis of the insertion rod; a first pin extending from and fixed relative to said v-shaped gripping surface; and a second pin extending through and movable relative to said v-shaped gripping surface between a first position wherein the second pin extends from the v-shaped gripping surface a distance x and a second position wherein the second pin extends a distance less than x from the v-shaped gripping surface, wherein said first pin and said second pin are offset on said v-shaped gripping surface and extend in a non-parallel manner.”

Similarly, Independent claim 20 recites “[a]n implant insertion device comprising: an insertion rod having a longitudinal axis; and an implant gripper extending from said insertion rod, said implant gripper including: an implant gripping surface intersecting the longitudinal axis of the insertion rod; a first pin extending from and fixed relative to said implant gripping surface; and a second pin extending through and movable relative to said implant gripping surface, said second pin being substantially aligned with said longitudinal axis of said insertion rod and non-parallel to said first pin.”

Independent claim 21 recites “[a]n implant insertion device comprising: a handle having a gripping surface; an insertion rod extending from said handle, said insertion rod defining a longitudinal axis; an implant gripper extending from said insertion rod, said implant gripper including: an implant gripping surface intersecting the longitudinal axis of the insertion rod; a first pin extending from and fixed relative to said implant gripping surface; and a second pin

extending through and movable relative to said implant gripping surface, said second pin being substantially aligned with said longitudinal axis of said insertion rod and non-parallel to said first pin; and an actuator positioned proximal to said handle for moving the second pin relative to said v-shaped gripping surface."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"To establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143. Additionally, as set forth by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), it is necessary to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed.

As explained during the interview, each of the independent claims recites a gripping surface intersecting the longitudinal axis of the insertion rod. A first pin extends from this gripping surface. Additionally, a second pin extends through and is moveable relative to this gripping surface. This configuration allows the implant to be held securely while allowing the tool to be easily removed from the implant with an axial motion, thereby requiring minimal space.

Zucherman et al. does not teach or suggest the claimed invention. The Office Action cites to the implant gripper (5030) shown in Figs. 184, 185 and 194. During the interview, the Examiner acknowledged that she had not identified a specific gripping surface, but instead was looking at the shape of the insertion tip 5030.

As explained during the interview, pins 5560, which are indicated in the Office Action as equivalent to the recited first pin, extend from surface 5565. As shown in Fig. 186a, surface 5565 does not intersect the longitudinal axis of the insertion rod. To the contrary, surface 5565 extends parallel to the longitudinal axis of the insertion rod and thereby, pins 5560 extend perpendicular to the axis. With this configuration, the tool 5500 must be moved a direction perpendicular to the axis to disengage the tool 5500 from an implant, thereby requiring additional space around the implant.

Furthermore, driver 5555, which is indicated in the Office Action as equivalent to the recited second pin, does not extend through and move relative to the surface 5565. Instead, as shown in Figs. 186a-186c, the driver 5555 extends parallel to the surface 5565 and not through the surface 5565 and moves within the opening 5567 which is clear of the surface 5565. Zucherman et al. alone or in any reasonable combination fails to teach or suggest each limitation of the claimed invention.

It is respectfully submitted that independent claims 1, 20 and 21 are in condition for allowance. Claims 3-5 all ultimately depend from claim 1 and are therefore allowable for, *inter alia*, the reasons set forth above. Additionally, withdrawn claims 6-19 all ultimately depend from independent claim 1 and should be reinstated and allowed as dependent upon an allowable generic claim.

Conclusion

It is respectfully submitted that each of the pending claims is in condition for allowance. Early reconsideration and allowance of each of the pending claims are respectfully requested.

If the Examiner believes a further interview, either personal or telephonic, will advance the prosecution of this matter, the Examiner is invited to contact the undersigned to arrange the same.

Respectfully submitted,



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Dated: May 13, 2009

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